

REMARKS

The paper is in response to the Office Action mailed March 18, 2011 ("the Office Action"). The foregoing amendment amends claims 21, 25, 27, 34-36, and 41. Claims 21-52 remain pending in view of the amendments. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

Claim Objections

The Office Action objects to claim 21 for minor claim informalities. Claim 21 has been amended to correct such informalities. The other amendments to the claims were also made to

correct other similar informalities in the claims. As such, the Applicant respectfully requests that the objections to claim 21 be withdrawn.

Rejection under 35 U.S.C §103(a)

The Office action rejects claims 21-25, 27-40, and 52 under 35 U.S.C §103(a) over *Ohtomo* (U.S. Patent No. 6,859,269) in view of *Turner et al* (European Patent No. 0587328) in further view of *Kim* (U.S. Patent Publication No. 2002/0080064) and rejects claims 41-51 under 35 U.S.C §103(a) over *Ohtomo* in view of *Turner et al* in view of *Kim* in further view of *Alhadeef et al* (U.S. Patent Publication No. 2003/0202089). The Office action also rejects claim 26 over *Ohtomo* in view of *Turner et al* in view of *Kim* in further view of Applicant admitted prior art (AAPA at specification page 2 lines 11-12 "an example of this is the classical trilinear surveying method").

Under 35 U.S.C §103(a), "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." According to MPEP §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Finally, MPEP 2141.III notes that:

"The key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.*** The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that ***"[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."*** *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396." (emphasis added)

Independent claim 21 requires, for example:

a positioning system which is based on the reception of shadowable signals of the positioning system and a **dead range** within which the propagation of the shadowable signals of the positioning system are impaired in **such** a way **that a**

direct determination of the actual position by means of the positioning system is at least **limited** [and]

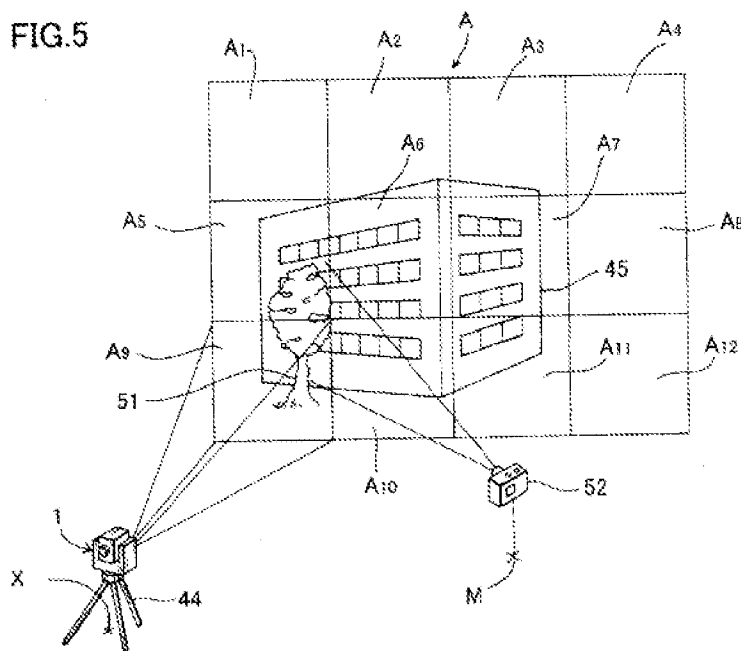
...recording of a first piece of image information from a first known position determined by means of the positioning system which is based on the reception of shadowable signals of the positioning system and the **dead range** within which the propagation of the signal is impaired in such a way that a direct determination of the actual position by means of the positioning system is at least **limited**....

By contrast, the portion of Othomo cited to Col. 1, line 65 to Col. 2, line 5 of Othomo reads:

Also, the present invention provides the surveying instrument as described above, wherein there is provided another pick-up means, an **image** of a portion where the **image is lacking** in the image being acquired by the image pick-up means is acquired, and the control arithmetic unit complements the **image-lacking** portion of the image pick-up means by the **image** of another image pick-up means and prepares a synthesized **image** (emphasis added)

And, with reference to Figure 5 (below), Othomo teaches at column 6, lines 9-11:

Further, the complementary image data is synthesized to the entire synthesized image A. The lacking portion due to the shadow of the tree 51 is complemented, and an entire synthesized **image** of the construction 45 is acquired with the tree 51 erased.



As set forth in claim 21, the "dead range" according to the claimed invention refers to impaired **positioning signals**, such as GPS signal, not imagery of an of a tree, forming an obstacle between the surveying instrument and an object to be imaged. Quite simply, Ohtomo says nothing about positioning **signals** being impaired by that tree as required by claim 21. As such, Ohtomo does not teach or suggest the claimed invention.

The Examiner concedes on page 5, 2nd paragraph that Turner does not disclose a "dead range" feature as required by claim 21 as well:

Turner is silent and does not recite in exact claim language the reception of the **signals of the positioning system are shadowable** and impaired and in the dead range (obstructed).

(Emphasis added).

The "dead range" feature is, however, essential for the present invention, because it constitutes the motivation and predictable reason for the man skill in the art to obtain the invention. *See also In re. Kao*, Fed. Cir, 2010-1308 (May 13, 2011) ("The Board has not provided any reason, apart from its own statement to the contrary, to question this conclusion. The Board's own conjecture does not supply the requisite substantial evidence to support the rejections, i.e., 'such evidence as a reasonable mind might accept as adequate to support a conclusion.' *Consol. Edison Co. v. Nat'l Labor Relations Bd.*, 305 U.S. 197, 229 (1938).") (Emphasis added).

In order to find support for the missing "dead range" claimed feature, the Examiner cites Kim. According to the abstract, Kim refers to a hybrid method with:

A position determination method, in which a global positioning system (GPS) is used, a a position determining method, in which a mobile communication signal is used, **by combining the above two methods with each other**

(Emphasis added).

This statement says nothing about the required "dead range" feature either. Kim foresees a combination of two independent position determining results, a first one from the GPS signal and a second one from the mobile communication signal. According to Fig. 4, a first position

calculator 32 dedicated for the GPS signal and a second position calculator 33 for the mobile communication signal send data to a position calculation server 306. The present invention, as claimed, does not refer to such a hybrid method. As such, the Applicant respectfully requests that the rejections of claim 21 be withdrawn as none of the references teach or suggest the claimed "dead range" feature required by claim 21.

The Office Action rejects claims 22-52 over various references. Those claims variously depend on claims discussed above. Thus, in light of the remarks presented above, the Office Action does not present a *prima facie* case that those claims are not patentable. Applicants therefore respectfully request that Examiner withdraw the rejection of claims 22-52.

Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 50-5394: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 50-5394.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 17th day of June, 2010.

Respectfully submitted,

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